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USSN: 09/410,462
PATENT

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13 Nov 2006

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Gary R Fabian

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Williams, A., et al.

Confirmation No. 6889

Serial No.: 09/410,462

Art Unit: 1635

Filing Date: 1 October 1999

Examiner: J.E. Angell

Title: A SINGLE AGENT METHOD FOR KILLING TUMOR AND TUMOR
ASSOCIATED ENDOTHELIAL CELLS USING ADENOVIRAL MUTANTS

RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office action, dated 12 July 2006, in the above-referenced application. The response date with one-month extension is Sunday, 12 November 2006. Accordingly, the response date with one-month extension is Monday, 13 November 2006. A one-month extension of time to respond is requested, and the fee therefore accompanies this paper (\$60.00 at small entity rate). An authorization for payment of this fee accompanies this paper in the Petition for Extension of Time. No further fee is believed due; however, the Commissioner is hereby authorized to charge to Deposit Account No. 15-0615 any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.21 which may be required by this paper, with the exception of the payment of the issue fee. Reconsideration of the application in view of the following remarks is respectfully requested.

Introductory Comments

I. Summary of the Office Action.

The Examiner rejected claims 6, 7, 11-13, 15, 17, 18 and 29 under 35 U.S.C. §102(e) asserting that the claims are anticipated by Bischoff, et al. (U.S. Patent No. 6,080,578).

The Examiner rejected claim 22 under 35 U.S.C. §102(b) asserting that the claims are anticipated by Whyte, et al. (J. Virol. 1988, previously of record).

The Examiner rejected claim 23 under 35 U.S.C. §102(b) asserting that the claims are anticipated by Jelsma, et al., (Virol. 1989, previously of record).

The Examiner rejected claims 6-13, 15, 17-20, 22, 23, and 26-34 under 35 U.S.C. §112, first paragraph, asserting that the specification, “while being enabling for: methods of selectively killing dividing cells in a population of dividing and quiescent cells by administering a replication competent adenovirus comprising a mutation in an E1A CR2 RB family member binding region directly to the target dividing cells, does not reasonably provide enablement for the full scope of the claims.” (Office action, dated 12 July 2006, page 5, emphasis in original.)

The following rejections were withdrawn by the Examiner:

The Examiner withdrew the rejection of claims 1-20 under 35 U.S.C. §112, first paragraph.

The Examiner withdrew the rejection of claims 1-6 under 35 U.S.C. §102(e) which asserted that the claims were anticipated by Bischoff, et al. (U.S. Patent No. 6,080,578). The rejection was withdrawn in view of the cancellation of claims 1-5. The above-asserted rejection of claims 6, 7, 11-13, 15, 17, 18 and 29 under 35 U.S.C. §102(e) relative to Bischoff, et al. (U.S. Patent No. 6,080,578) “is considered new grounds of rejection as it encompasses a different claim set” (Office action, dated 12 July 2006, page 8).

The Examiner withdrew the rejection of claims 22-24 and 26-28 under 35 U.S.C. §112, second paragraph.

The pending rejections are traversed for reasons discussed below.